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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,878	11/17/2000	Patrick Rivelli JR.	5877-0011.30	7631

490 7590 02/24/2004

VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA, MN 55343-9185

EXAMINER

HO, UYEN T

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/715,878

Applicant(s)

RIVELLI, PATRICK

Examiner

(Jackie) Tan-Uyen T. Ho

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 22, 23.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The information disclosure statements (IDSs) submitted on 3/24/2003 and 8/15/2003 have been considered.

Response to Amendment

2. The amendment filed 8/14/2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

Claim 1, lines 8-10, the limitation "the stent's as cut state, the distance between adjacent sides of a wave on proceeding from a peak toward opposite peaks, increases monotonically with an inflection point therebetween" is not support by the original specification. The original specification discloses the stent being cut from the tube so inherently the stent would have a cut state. However, the original specification does not support as in the cut state "the distance between adjacent sides of a wave on proceeding from a peak toward opposite peaks, increases monotonically with an inflection point therebetween."

Claims 7, 12 and 17, lines 2-3 of each claim, the limitation "the stent diameter in its as cut state is between 2-9 times that in its contracted state" is not supported by the original specification.

Claim 12, the limitation "radial expansion of the stent from its contracted to its as cut state ..., without significant change in the axial dimension of the stent" is not support

Art Unit: 3731

by the original specification. The original specification discloses the stent being cut from the tube so inherently the stent would have a cut state. However, the original specification does not support "radial expansion of the stent from its contracted state to its as cut state..., without significant change in the axial dimension of the stent."

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The subject matters as follow:

Claim 1, lines 8-10, the limitation "the stent's as cut state, the distance between adjacent sides of a wave on proceeding from a peak toward opposite peaks, increases monotonically with an inflection point therebetween" is not support by the original specification. The original specification discloses the stent being cut from the tube so inherently the stent would have a cut state. However, the original specification does not support how the stent being cut to make as in the cut state "the distance between

Art Unit: 3731

adjacent sides of a wave on proceeding from a peak toward opposite peaks, increases monotonically with an inflection point therebetween."

Claims 7, 12 and 17, lines 2-3 of each claim, the limitation "the stent diameter in its as cut state is between 2-9 times that in its contracted state" is not supported by the original specification.

Claim 12, the limitation "radial expansion of the stent from its contracted to its as cut state ..., without significant change in the axial dimension of the stent" is not support by the original specification. The original specification discloses the stent being cut from the tube so inherently the stent would have a cut state. However, the original specification does not support "radial expansion of the stent from its contracted state to its as cut state..., without significant change in the axial dimension of the stent."

5. Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1, lines 8-10, the limitation "the stent's as cut state, the distance between adjacent sides of a wave on proceeding from a peak toward opposite peaks, increases monotonically with an inflection point therebetween" is not support by the original specification. The original specification discloses the stent being cut from the tube so inherently the stent would have a cut state. However, the original specification does not support how the stent being cut to make as in the cut state "the distance between

Art Unit: 3731

adjacent sides of a wave on proceeding from a peak toward opposite peaks, increases monotonically with an inflection point therebetween."

Claims 7, 12 and 17, lines 2-3 of each claim, the limitation "the stent diameter in its as cut state is between 2-9 times that in its contracted state" is not supported by the original specification. The specification discloses in an expanded state the having a diameter between 2-9 times that in its contracted state. The specification does not disclose a tube being 2-9 times as in its contracted state in order to make a stent having a diameter in its as cut state between 2-9 times than in its contracted state.

Claim 12, the limitation "radial expansion of the stent from its contracted to its as cut state ..., without significant change in the axial dimension of the stent" is not support by the original specification. The original specification discloses the stent being cut from the tube so inherently the stent would have a cut state. However, the original specification does not support "radial expansion of the stent from its contracted state to its as cut state..., without significant change in the axial dimension of the stent." The original specification does not disclose how big the tube and how the stent being cut such that at as its cut state and contracted state, the stent is not changed its length.

6. Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a stent's in its expanded state, does not reasonably provide enablement for a stent's in its as cut state. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. See the reasoning in the paragraph above.

Art Unit: 3731

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Jackie) Tan-Uyen T. Ho whose telephone number is (703) 306-3421. The examiner can normally be reached on MULTIFLEX Mon. to Sat..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703) 308-2496. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



(Jackie) Tan-Uyen T. Ho
Patent Examiner
Art Unit 3731
February 23, 2004